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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. HARPER and ROBERT E. HAINES

Appeal 2008-4143
Application 09/665,349
Technology Center 3600

Decided: December 1, 2008

Before HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-20 and 22-33. Claim 21 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is directed to a method of programming a memory unit in a hard copy output engine. The method includes determining an electronic address for a supplier appropriate to the geographical area and programming the electronic address into the memory unit. (Specification, 2:14-19). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method of programming a non-volatile memory unit in a hard copy output engine comprising:
determining a geographical area within which the hard copy output engine is to be deployed;
determining an electronic address for a consumables supplier appropriate to the geographical area; and programming the electronic address into the non-volatile memory.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Dent	US 5,884,073	Mar. 16, 1999
Himmel	US 6,041,360	Mar. 21, 2000
Beard	US 6,016,409	Jan. 18, 2000
Gosling	US 6,247,044	June 12, 2001

The following rejections are before us for review:

1. Claims 1, 4, 6, 8, 11-12, 14-15, 17, 19, and 22-33 are rejected under 35 U.S.C. § 102(e) as anticipated by Beard¹.

¹ We note that the Appellant has provided arguments for claims

2. Claims 2-3, 7, 9-10, 16, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Beard and Dent.

3. Claim 5 is rejected under 35 U.S.C. § 103(a) as unpatentable over Beard and Himmel.

4. Claims 13 and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Beard and Gosling.

THE ISSUE

The first issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 4, 6, 23-25, 28, and 32-33 under 35 U.S.C. § 102(e) as anticipated by Beard. This issue turns on whether Beard discloses the “consumables supplier be appropriate to the geographical area within which the hard copy output is to be deployed”.

The second issue is whether the Appellants have shown that the Examiner erred in rejecting claims 8, 11-12, 14-15, 17, 19, 22, 26-27, and 29-31 under 35 U.S.C. § 102(e) as anticipated by Beard. This issue turns on whether Beard inherently discloses “extracting an electronic address for a vendor...from a non-volatile memory”.

The third issue is whether the Appellants have shown that the Examiner erred in rejecting claims 2-3, 7, 9, and 20 under 35 U.S.C. § 103(a) as unpatentable over Beard and Dent. This issue turns on whether it would have been obvious to one of ordinary skill in the art to combine the references as proposed by the Examiner.

The fourth issue is whether the Appellants have shown that the Examiner erred in rejecting claims 10 and 16 under 35 U.S.C. § 103(a) as unpatentable over Beard and Dent. This issue turns on whether Beard discloses the “consumables supplier be appropriate to the geographical area within which the hard copy output is to be deployed”.

The fifth issue is whether the Appellants have shown that the Examiner erred in rejecting claim 5 under 35 U.S.C. § 103(a) as unpatentable over Beard and Himmel. This issue turns on whether it would have been obvious to one of ordinary skill in the art to combine the references as proposed by the Examiner.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence²:

FF1. Beard discloses a system for replacing fuser modules in a digital printing apparatus (col. 1:1-14).

FF2. Beard discloses that a service plan code can be placed in a one-time programmable memory of the CRUM. A lease arrangement can instruct the distribution board 30 to send a request to re-order new modules (such as a printer fuser) through the network or over a phone line to a manufacturer (col. 8:13-37).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF3. Beard discloses that the CRUM code of the market region for the modules and machine match. This enables a machine designed for 110V instead of 220V to use an appropriate module for that region (col. 8:44-56).

FF4. Beard does not explicitly disclose selecting the supplier or vendor to be appropriate to the geographical area in which the hard copy output is to be deployed (col. 8:44-56).

FF5. For a computer to communicate with other computers and Web Servers on the Internet, it must have an IP address. An IP address (IP stands for Internet Protocol) is a unique 32-bit number that identifies the location of a particular computer on a network. <http://www.howstuffworks.com> (obtained on Nov. 11, 2008).

FF7. Dent discloses a system to alter the boot sequence through an electronic system through a privately or publicly accessible network in the event of a boot error (col. 3:3-8).

FF8. Himmel discloses web browser support for the dynamic update of bookmarks. When a change is detected in the web page data in a first bookmark, it is automatically updated by virtue of its dynamic attribute to reflect the change in web page data (Abstract).

PRINCIPLES OF LAW

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope

of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that

“the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

Claims 1, 4, 6, 8, 11-12, 14-15, 17, 19, and 22-33 rejected under 35 U.S.C. § 102(e) as anticipated by Beard

The Appellant argues that the rejection of claims 1, 4, 6, 23-25, 28, and 32-33³ under 35 U.S.C. § 102(e) as anticipated by Beard is improper because the reference fails to disclose “determining an electronic address for a consumables supplier or vendor appropriate to a geographical area in which the hard copy output is to be deployed” (Br. 3).

The Examiner has determined that it is inherent that Beard provides an electronic address for the supplier or service organization (Ans. 5). The Examiner has determined that Beard also discloses a market region code which is placed by the manufacturer in the CRUM memory that identifies the module as belonging to a particular region (Ans. 14, 19).

We agree with the Appellants. Regardless of whether Beard discloses an “electronic address” for a supplier or vendor both claims 1 and 23 require that the “consumables supplier be appropriate to the geographical area within which the hard copy output is to be deployed.” Beard does disclose that the CRUM module code for the market region for the “modules” and “machine” match (FF3). Beard however does not disclose selecting the “consumables supplier” be appropriate to the geographical area in which the hard copy output is to be deployed (FF4). A market region code for the “module” is not the same as market region code for a “consumable supplier.”

³ The Examiner has rejected claims 1, 4, 6, 8, 11-12, 14-15, 17, 19, and 22-33 under 35 U.S.C. § 102(e) as anticipated by Beard. We note that the Appellant has argued that the rejection of claims 1-7, 23-25, 28, and 32-33 is improper under 35 U.S.C. § 102(e) as anticipated by Beard (Br. 3-6). The Appellants arguments drawn to claims which are not rejected are considered moot.

As Beard fails to disclose the limitation for “determining an electronic address for a consumables supplier or vendor appropriate to a geographical area in which the hard copy output is to be deployed” the rejection of claims 1 and 23 under 35 U.S.C. § 102(e) as anticipated by Beard is not sustained. The rejection of dependent claims 4, 6, 24-25, 28, and 32-33 under 35 U.S.C. § 102(e) as anticipated by Beard is not sustained for the same reasons.

Claims 8, 11-12, 14-15, 17, 19, 22, 26-27, and 29-31 rejected under 35 U.S.C. § 102(e) as anticipated by Beard

The Appellants argue that the rejection of claims 8-14, 15-20, 22, 26-27, 29-31⁴ under 35 U.S.C. § 102(e) as anticipated by Beard is improper because the claims recite “extracting an electronic address for a vendor or supplier of a consumable from memory” (Br. 6). The Appellant argues that it is not inherent that Beard stores an electronic address because Beard could use a token ring arrangement (Br. 7). The Appellant argues that it is not inherent that Beard stores an electronic address because a label could be scanned or that Beard may poll or pull information from the printing apparatus in alternative conditions (Reply Br. 6).

The Examiner has determined that it is inherent that Beard provides an electronic address for the supplier in order to communicate with the

⁴ The Examiner has rejected claims 1, 4, 6, 8, 11-12, 14-15, 17, 19, and 22-33 under 35 U.S.C. § 102(e) as anticipated by Beard. We note that the Appellant has argued that the rejection of claims 8-14, 15-20, 22, 26-27, and 29-31 is improper under 35 U.S.C. § 102(e) as anticipated by Beard (Br. 6-7). The Appellants arguments drawn to claims which are not rejected are considered moot.

supplier (Ans. 5-7). The Examiner has determined that every computer has a unique address in order to communicate with other computers in a network (Ans. 6).

We agree with the Examiner. Claim 8 requires “extracting an electronic address for a vendor...from a non-volatile memory.” Claim 15 recites a limitation to “extract the electronic address from the non-volatile memory.” The Examiner had determined that it is inherent that Beard’s device uses an electronic address for the supplier (5-7).

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted).

For a computer to communicate with other computers and Web Servers on the Internet it must have an IP address (FF5). Therefore in order for Beards network system device to communicate with a supplier it must inherently have an IP address with which to contact. The Appellant’s argument that Beards device may use a label (bar code) that could be scanned or that Beard may poll or pull information from the printing apparatus in alternative conditions to an electronic address to communicate with the supplier is not taken. Ultimately, whether a token ring is used, a bar code label is used, or a poll is taken from the supplier, the suppliers will be communicated to by an unique electronic IP address.

For the reasons above, the rejection of claims 8 and 15 under 35 U.S.C. § 102(e) as anticipated by Beard is sustained. The Appellant has not argued the rejections of claims 11-12, 14, 17, 19, 22, 26-27, and 29-31 separately and the rejection of these claims under 35 U.S.C. § 102(e) as anticipated by Beard is sustained for the same reasons.

Claim 2-3, 7, 9, and 20 under 35 U.S.C. § 103(a) by Beard and Dent

The Appellants argue that the rejection of claims 2-3, 7, 9, and 20 under 35 U.S.C. § 103(a) as obvious in view of Beard and Dent is improper because there is no motivation for the combination (Br. 10). Specifically, the Appellants argue that Beard is replete with teachings of the printing apparatus communicating with the manufacturer and that the rejection fails to identify any problems that would be solved by a combination with the disclosure of Dent.

The Examiner has determined that Dent discloses a system which enables remote system level diagnostics through a private or public network in the event of failure to obtain a web address for a service provider (Ans. 10-11.) The Examiner has found that the combination of Beard and Dent would be made to establish communications with a remotely located service provider via a network (Ans. 25).

We agree with the Examiner. Dent discloses a system to alter the boot sequence through an electronic system through a privately or publicly accessible network in the event of a boot error (FF6). The modification of the system of Beard with the disclosure of Dent to access the network in the event of boot error is considered a predictable combination of prior art elements according to their established functions. For the above reasons the

rejection of claims 9 and 20 under 35 U.S.C. § 103(a) as obvious in view of Beard and Dent is sustained.

We note that claims 2-3 and 7 have been rejected under 35 U.S.C. § 103(a) as obvious in view of Beard and Dent but depend from claim 1. We have found that Beard fails to disclose the limitation for “determining an electronic address for a consumables supplier appropriate to a geographical area in which the hard copy output is to be deployed” (see section above) and Dent fails to cure this deficiency. For these reasons the rejection of claims 2-3 and 7 under 35 U.S.C. § 103(a) as obvious in view of Beard and Dent is not sustained.

Claim 10 and 16 under 35 U.S.C. § 103(a) by Beard and Dent

The Appellants argue that the rejection of claims 10 and 16 under 35 U.S.C. § 103(a) as obvious in view of Beard and Dent is improper because Beard fails to disclose or suggest an electronic address for the vendor appropriate to the area in which the hard copy output engine is to be deployed (Br. 10).

The Examiner has determined that Beard discloses a market region code which is placed by the manufacturer in the CRUM memory that identifies the module as belonging to a particular region (Ans. 26-27).

We agree with the Appellants. The claims require that the “supplier or vendor be appropriate to the geographical area in which the hard copy output is to be deployed.” Beard does disclose that the CRUM module code for the market region for the “modules” and “machine” match (FF3). Beard however does not disclose selecting the “supplier” or “vendor” to be appropriate to the geographical area in which the hard copy output is to be

deployed (FF4). A market region code for the “module” is not the same as market region code for a “supplier” or “vendor.” As Beard fails to disclose that the “supplier or vendor be appropriate to the geographical area in which the hard copy output is to be deployed,” the rejection of claims 10 and 16 under 35 U.S.C. § 103(a) as unpatentable over Beard and Dent is not sustained.

Claim 5 rejected under 35 U.S.C. § 103(a) by Beard and Himmel

The Appellants argue that the rejection of claim 5 under 35 U.S.C. § 103(a) as obvious in view of Beard and Himmel is improper.

Beard fails to disclose the limitation for “determining an electronic address for a consumables supplier or vendor appropriate to a geographical area in which the hard copy output is to be deployed” for the reasons given above and Himmel fails to cure this deficiency in the rejection. As both Beard and Himmel fail to disclose “determining an electronic address for a consumables supplier or vendor appropriate to a geographical area in which the hard copy output is to be deployed” the rejection of claim 5 under 35 U.S.C. § 103(a) as obvious in view of Beard and Himmel is not sustained.

Claims 13 and 18 rejected under 35 U.S.C. § 103(a) by Beard and Gosling

The Appellants have not specifically argued against the rejection of claims 13 and 18 under 35 U.S.C. § 103(a) as obvious in view of Beard and

Himmel. Accordingly, the rejection of claims 13 and 18 under 35 U.S.C. § 103(a) as unpatentable over Beard and Gosling is sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 4, 6, 23-25, 28, and 32-33 under 35 U.S.C. § 102(e) as anticipated by Beard.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 8, 11-12, 14-15, 17, 19, 22, 26-27, and 29-31 under 35 U.S.C. § 102(e) as anticipated by Beard.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 2-3 and 7 under 35 U.S.C. § 103(a) as unpatentable over Beard and Dent. We conclude that Appellants have not shown that the Examiner erred in rejecting claims 9 and 20 under 35 U.S.C. § 103(a) as unpatentable over Beard and Dent.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 10 and 16 under 35 U.S.C. § 103(a) as unpatentable over Beard and Dent.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 5 under 35 U.S.C. § 103(a) as unpatentable over Beard and Himmel.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 13 and 18 under 35 U.S.C. § 103(a) as unpatentable over Beard and Gosling.

DECISION

The Examiner's rejection of claims 1, 2-7, 10, 16, 23-25, 28, and 32-33 is not sustained. The Examiner's rejection of claims 8-9, 11-13, 14-15, 17-20, 22, 26-27, and 29-31 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

JRG

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